



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. 09/925,065 Art Unit: 1634
Applicant: Wang, David G. Examiner: Switzer, Juliet Caroline
Date Filed: August 8, 2001 Conf. No. 2603
Docket No. 108827.135 Cust. No. 23483
Title: IDENTIFICATION AND MAPPING OF SINGLE NUCLEOTIDE
POLYMORPHISMS IN THE HUMAN GENOME

CERTIFICATION UNDER 37 CFR § 1.8(a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date set forth below.

June 20, 2005
Date of Signature and of Mail Deposit

Rochelle Harper Greenidge
Rochelle Harper Greenidge

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION FROM RESTRICTION REQUIREMENT UNDER 37 C.F.R. §1.144

Dear Sir:

On July 1, 2004, a Restriction Requirement was made limiting the sole claim in the above-referenced application ("Application"). Applicant elected, with traverse, SEQ ID Nos. 1-12,108 on October 1, 2004, and amended claim 1 accordingly.

In an Office Action dated February 18, 2005, the restriction requirement (made July 1, 2004) was made final.

Applicant petitions the Director to review this restriction requirement.

Herewith, Applicant is filing a request to convert this Application into a Statutory Invention Registration (SIR) (copy of Request enclosed). This Application contains the sequences of 959,027 SNP nucleic acids sequences, all of which Applicant desires to dedicate to

the public domain through a Statutory Invention Registration ("SIR"). Applicant's goal is to allow scientists to freely work on these sequences and possibly identify new diseases and/or correlate the sequences with existing disease states. By converting this Application into an SIR, Applicant will be able to use the SIR defensively as a prior art document to ensure that no one entity can patent a sequence disclosed in this Application, as patenting will remove that sequence from the public domain and prevent the work of scientists on that sequence.

As this Application will never issue as a patent, Applicant respectfully avers that the restriction requirement should not be maintained, since SIRs are not required to meet the requirements of patentability under 35 U.S.C. §102 or 35 U.S.C. §103. Thus, no search for prior art needs to be done of the sequences of the Application's sole claim. Moreover, it is not unduly burdensome for the Examiner to examine all of the sequences, since an SIR need only meet the requirements of 35 U.S.C. §112, which Applicant avers that the Application does.

Accordingly, Applicant respectfully requests that the Director reconsider and withdraw the restriction requirement in this Application, allow the Applicant to amend claim 1 to its original state (which claimed all 959,027 sequences), and allow simultaneous examination of all of the SNP nucleic acid sequences in the Application's sole claim.

CONCLUSION

Applicant filed this Application containing 959,027 sequences with the intention of dedicating these sequences to the public domain through an SIR. As an SIR does not need to meet the requirements of 35 U.S.C. §102 or 35 U.S.C. §103, Applicant respectfully avers that it is not unduly burdensome for all 959,027 sequences to be examined together. Accordingly, Applicant respectfully requests that the restriction requirement be reconsidered and withdrawn.

If the Director believes that any further discussion of this communication would be helpful, s/he is encouraged to contact the undersigned by telephone.

U.S. Serial No. 09/925,065
Petition under 37 CFR §1.144

No fees are believed to be due in connection with this communication. However, please apply any additional charges, or credit any overpayment, to our Deposit Account No. 08-0219.

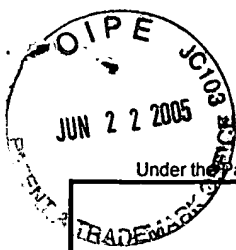
Respectfully submitted,
WILMER CUTLER PICKERING
HALE AND DORR LLP



Nancy Chiu Wilker, Ph.D.
Reg. No. 43,545
Attorney for Applicant

Date: June 20, 2005

60 State Street
Boston, MA 02109
(617) 526-6000
(617) 526-5000 (fax)



Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

Request for Statutory Invention Registration

Application Number 09/925,065, or ☐ attached heretoFiled: August 8, 2001Applicant(s): Wang, David G.Title: Identification and Mapping of Single Nucleotide Polymorphisms in the Human Genome.

A. In the above identified patent application, I hereby:

1. Request and authorize the Director of the U.S. Patent and Trademark Office to publish the above identified regularly filed patent application as a Statutory Invention Registration. (35 U.S.C. 157)
2. Waive the right to receive a United States patent on the same invention claimed in the above identified patent application. These rights, which are waived, include those specified in 35 U.S.C. 183 and 271 through 289 as well as all attributes specified for patents in any other provisions of law other than title 35, United States Code. The waiver includes, but is not limited to, the remedies under 19 U.S.C. 1337, 22 U.S.C. 2356 and 28 U.S.C. 1498. (35 U.S.C. 157(c))
3. Understand that the above waiver will be effective pursuant to 37 CFR 1.293 upon publication of the Statutory Invention Registration to waive the inventor's right to receive a United States patent on the invention claimed in the Statutory Invention Registration. (37 CFR 1.293(b)(1))
4. State that, in my opinion, the disclosure and claims of the above identified patent application meet the requirements of 35 U.S.C. 112. (37 CFR 1.293(b)(3))
5. State that, in my opinion, the above identified patent application complies with the requirements for printing as set forth in the Rules of Practice for Patent Cases, 37 CFR Part 1. (37 CFR 1.293(b)(4))
6. Enclose the fee set forth in 37 CFR 1.17(n) or (o) for requesting publication of a Statutory Invention Registration:

☐ A first Office Action has not been mailed in the above application, 37 CFR 1.17(n) (fee code 1804) \$ _____☒ A first Office Action has been mailed in the above application, 37 CFR 1.17(o) (fee code 1805) \$ 1,840Request fee \$ 1,840**MINUS BASIC FILING FEE, IF PREVIOUSLY PAID**☒ Basic filing fee for utility patent application set forth in 37 CFR 1.16(a);☐ Basic filing fee for design patent application set forth in 37 CFR 1.16(f); or☐ Basic filing fee for plant patent application set forth in 37 CFR 1.16(g)

Minus basic filing fee \$ _____

Amount due \$ 1,130

Payment charged to credit card _____ Form PTO-2038 is attached.

Amount enclosed by check or money order _____

Please charge Deposit Account No. 08-0219 the amount of \$ 1,130. A duplicate copy of this form is attached.If payment of any additional fee is required for publication of the Statutory Invention Registration, charge such amount to Deposit Account No. 08-0219. A duplicate copy of this form is attached.

* Where this request is submitted at the time the application is filed, the filing fee is included in the fee.

(Page 1 of 2)

This collection of information is required by 35 U.S.C. 157. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 24 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

- B. For printing of the Statutory Invention Registration front page, if desired, list below the name(s) of not more than 3 registered patent attorneys and agents OR alternatively, the name of a firm having as a member a registered patent attorney or agent. If no name is listed below, no name will be printed on the Statutory Invention Registration.

Wilmer Cutler Pickering Hale and Dorr LLP

- C. Name of assignee, if any, for printing on the Statutory Invention Registration SNP Consortium

Address (City and State or Country) Chicago, IL

State of incorporation, if assignee is a corporation Delaware

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

The party or parties signing this form are:

☒ attorney or agent of record. Registration Number 43,545

☐ applicant(s) and any assignee

Nancy Chiu Wilker

Signature(s) (37 CFR 1.293(a))

Nancy Chiu Wilker, Ph.D.

Typed or Printed Name(s)

43,545

Registration Number, if applicable

(617) 526-6000

Telephone Number